



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,864	05/19/2000	Toshio Inadate	450100-02508	1674
20999	7590	04/22/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRAN, TONGOC	
			ART UNIT	PAPER NUMBER
			2134	8

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,864

Applicant(s)

INADATE, TOSHIO

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date, _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2134

DETAILED ACTION

1. This office action is in response to applicant's amendment filed on 1/30/2004.

Claims 1-5 are amended. Claims 6 and 8 are canceled. Claims 9-12 are added.

Claims 1-5, 7, 9-12 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 5,862,223) in view of Knee et al. (U.S. Patent No. 5,589,892).

In respect to claim 1, Walker discloses an information processing apparatus, a method and a computer-readable recording medium recorded a program for connecting a plurality of information terminal by way of a network (see Fig. 1-3), comprising:

"storing means for storing user information (see col. 14, lines 42-50);

authenticating means for authenticating said information terminal of a user based on said user information stored in said storing means (see col. 10, lines 26-43);

recording means for recording a request information transmitted by a first user authenticated by said authenticating means (see col. 14, lines 50-56);

searching means for searching said request information and said user information of a second user recorded by said recording means in response to a demand for a request list from said first user" (see col. 7, lines 30-35); and

transferring means for transferring said request list to said first user (col. 7, line 67-col. 8, line 1).

Walker does not explicitly disclose wherein said request list includes a mark which expresses the existence of service information. However, Knee discloses user receives listings with an asterick or "star" icon indicating that a product or service associated with each of the listing is available and may be ordered remotely by the user (see Knee, col. 36, line 67-col. 37, line 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Walker's teaching of transferring expert service listings to user with the Knee's teaching of providing a mark as an indicator of service availability.

In respect to claim 2, Walker and Knee disclose an information processing apparatus as claimed in claim 1. Walker further discloses "said user information includes a user ID, a password and an electronic mail address" (see Walker, col. 14, lines 42-49).

In respect to claim 3, Walker and Knee disclose an information processing apparatus as claimed in claim 2. Walker further discloses "said transferring means transfers said service information corresponding to said request information as a search result to said first user by an electronic mail based on said information terminal of said first user by an electronic mail based on said user information for the first user stored in said storing means" (see Walker, col. 7, lines 26-29).

In respect to claim 4, Walker and Knee disclose an information processing apparatus as claimed in claim 3. Walker further discloses "said service information includes an address information on the network for obtaining directly from said second user a desired information among said service information" (see Walker, col. 26, lines 45-57).

In respect to claim 5, Walker and Knee disclose an information processing apparatus as claimed in claim 1. Walker further discloses "supplying means for supplying a list of said request information recorded by said recording means to the said second user in response to a demand entered from the information terminal of said second user" (see col. 8, lines 16-39).

In respect to claim 7 and 9-12, the claim limitations are method claims that are substantially similar to apparatus claims 1-5. Therefore, claims 7 and 9-12 are rejected based on the similar rationale.

Conclusion

Art Unit: 2134

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
Art Unit: 2134

TT

April 8, 2004

Matthew Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137